

U.S. Serial No. 08/876,839
Filed: June 16, 1997
RESPONSE TO FINAL OFFICE ACTION, PAPER NO. 20

REMARKS

I. INTRODUCTION

This is a full and timely response to the Action mailed August 1, 2001. The Examiner has rejected claims 1-18 and 22-27. Claim 27 has been amended, and claims 1-18 and 22-27 remain pending in the present application. In view of the following remarks and amendments, reconsideration of the present patent application is respectfully requested.

II. REJECTION UNDER 35 U.S.C. § 112

The Examiner rejected claim 27 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Examiner rejected claim 27 arguing that the limitation "said plurality of routing lists" lacks sufficient antecedent basis. Claim 27 has been amended to recite "a plurality of routing lists." Thus, amended claim 27 is not indefinite, and withdrawal of the rejection is respectfully requested.

III. CLAIMS 1-16 and 22-27 ARE NOVEL

The Examiner rejected claims 1-16 and 22-27 under 35 U.S.C. 102(e) as being unpatentable over U.S. Patent No. 5,746,747 to *Yue et al.* The Examiner argued that regarding claims 1-7, 11, 13, 22-24, and 27, *Yue* discloses, in an integrated computer telephony system including a call routing system, a system and method for routing a call based on the identity of an originating source of said call, comprising the step of: maintaining a plurality of routing lists for a telephony subscriber, each of said routing lists comprising a plurality of directory numbers where the subscriber can be reached, and for each of said routing lists: associating each routing list with at least one originating source; and determining an order of said directory numbers. The Examiner further argued that *Yue*

U.S. Serial No. 08/876,839
Filed: June 16, 1997
RESPONSE TO FINAL OFFICE ACTION, PAPER NO. 20

discloses the steps of receiving said call from a first originating source; identifying said first originating source of said call; selecting a routing list from said plurality of routing lists based on the identity of said first originating source; and directing said call sequentially to the directory numbers on said routing list selected.

However, *Yue* does not disclose all of these elements. Specifically, *Yue* does not disclose selecting a routing list from said plurality of routing lists **based on the identity of said first originating source**. Rather, *Yue* discloses a personal number communications system that assigns a personal number to each subscriber and receives from each subscriber communication routing information in one or more hierarchical lists of destinations based on the time of day and day of week. However, *Yue* does not disclose selecting a routing list based on the identity of the originating source. In fact, no selection process is disclosed in *Yue*. Rather, *Yue* discloses routing all incoming calls to destinations described in a single hierarchical list for a given time period that are associated with a subscriber's personal number. At most, the system disclosed in *Yue* discloses a system composed of multiple hierarchical lists of destinations associated with different times of a day or days of a week. One list is associated with one time period so that all incoming calls are routed to the listed destinations in the same order. Therefore, *Yue* fails to disclose routing calls based upon the identity of an originating source. For at least this reason, *Yue* does not anticipate independent claims 1, 5, 11, 13, and 27, and those claims depending therefrom.

The Examiner argued that as regarding claims 8-10, *Yue* discloses selecting a routing list from a group of routing lists identified for the originating party based on the day of the week and/or the time of the day the communication is received. However, *Yue* does not disclose selecting a routing list from a **group of routing lists identified for the originating party**. Instead, *Yue* discloses a system that directs calls made to a personal number to various destinations that are listed within a hierarchical list. Further, *Yue* discloses that the personal number can be associated to a different hierarchical list for different times of a day

U.S. Serial No. 08/876,839
Filed: June 16, 1997
RESPONSE TO FINAL OFFICE ACTION, PAPER NO. 20

or different days of a week. However, *Yue* does not disclose a system for selecting a routing list from a group of routing lists identified for the originating party. Rather, the different hierarchical lists disclosed in *Yue* are identical for every originating party. Thus, *Yue* does not anticipate claims 8-10.

The Examiner argued that regarding claim 15, *Yue*, at column 8, lines 11-24, discloses a computer-readable medium wherein the identifying criteria comprises a DTMF code sequence and the step of obtaining an identifying criteria further comprises detecting the non-DTMF code sequences. However, the cited portion of *Yue* discloses a method where non-priority callers can enter a code and have their call handled as if it were a priority call. Thus, claim 15 is not anticipated by the cited portion of *Yue*.

IV. CLAIMS 17 AND 18 ARE NOVEL

The Examiner rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Yue* in view of U.S. Patent No. 5,978,450 to *McAllister et al.* The Examiner argued that *Yue* discloses selecting a routing list based on a call identification telephone number. However, the Examiner admitted that *Yue* does not teach "a speech sample" that is used to identify a caller in order to route the call. The Examiner further argued that *McAllister* discloses a communication network comprising a peripheral that analyzes the speech of a caller in order to identify the caller.

However, 35 U.S.C. § 103(c) precludes *Yue* from being used to reject claims 17 and 18. Specifically, 35 U.S.C. § 103(c) provides that "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." At the time the invention was made, both inventors were subject to an obligation of assignment to the same

U.S. Serial No. 08/876,839
Filed: June 16, 1997
RESPONSE TO FINAL OFFICE ACTION, PAPER NO. 20

person, BellSouth Corporation as evidenced by the assignments filed with the PTO. Therefore, reliance on *Yue* in rejecting claims 17 and 18 is improper and withdrawal of the rejection is respectfully requested.

Furthermore, a *prima facie* case of obviousness has not been established. According to MPEP §2142, a *prima facie* case of obviousness must set forth the following elements:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the prior art reference (or references when combined) must teach or suggest all the claim limitations.

First, neither *McAllister* nor *Yue* teaches or suggests all of the claim elements. Specifically, neither reference discloses a system where an originating source provides a speech sample. *Yue* does not include any disclosure directed to a speech sample. Further, *McAllister* discloses a system for providing individualized telephone services to multiple subscribers using a common line based upon speech authentication of each subscriber, not an originating source. Moreover, neither reference discloses requesting an originating party to enter a speech sample, as claimed within claim 18. Thus, claims 17 and 18 are not obvious over *Yue* in view of *McAllister*.

Second, *McAllister* does not include any motivation to combine its teachings with *Yue*. In fact, the cited references teach away from each other. On one hand, *McAllister* discloses a voice recognition system for providing personalized services to multiple subscribers using a common line. On the other hand, *Yue* discloses a system for routing incoming calls to different destinations based upon the information supplied with the incoming call and according to a hierarchical list. Combining these two references would be illogical because the system disclosed in *McAllister* solves the problem of providing different

U.S. Serial No. 08/876,839
Filed: June 16, 1997
RESPONSE TO FINAL OFFICE ACTION, PAPER NO. 20

services to multiple subscribers using a common line. In contrast, the system disclosed in *Yue* solves a problem associated with a subscriber having a plurality of lines. Combination of these references would yield a system where a subscriber's speech is analyzed to determine what services are to be provided and a routing system for incoming calls. However, the combination lacks a system for routing incoming calls to various destinations based on **voice recognition of the originating source**. Therefore, claims 17 and 18 are not obvious under *Yue* in view of *McAllister*. Furthermore, claims 17 and 18 are patentable because they depend ultimately from allowable independent claims 1 and 4.

The preceding arguments address only the arguments in the Action, and therefore may not address patentable aspects of the invention that were not addressed by the Examiner in the Action. The claims may include other elements that are not shown, taught, or suggested by the cited references. Accordingly, the preceding arguments in favor of patentability are presented without prejudice to other bases of patentability.

U.S. Serial No. 08/876,839
Filed: June 16, 1997
RESPONSE TO FINAL OFFICE ACTION, PAPER NO. 20

person, BellSouth Corporation as evidenced by the assignments filed with the PTO. Therefore, reliance on *Yue* in rejecting claims 17 and 18 is improper and withdrawal of the rejection is respectfully requested.

Furthermore, a prima facie case of obviousness has not been established. According to MPEP §2142, a prima facie case of obviousness must set forth the following elements:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the prior art reference (or references when combined) must teach or suggest all the claim limitations.

First, neither *McAllister* nor *Yue* teaches or suggests all of the claim elements. Specifically, neither reference discloses a system where an originating source provides a speech sample. *Yue* does not include any disclosure directed to a speech sample. Further, *McAllister* discloses a system for providing individualized telephone services to multiple subscribers using a common line based upon speech authentication of each subscriber, not an originating source. Moreover, neither reference discloses requesting an originating party to enter a speech sample, as claimed within claim 18. Thus, claims 17 and 18 are not obvious over *Yue* in view of *McAllister*.

Second, *McAllister* does not include any motivation to combine its teachings with *Yue*. In fact, the cited references teach away from each other. On one hand, *McAllister* discloses a voice recognition system for providing personalized services to multiple subscribers using a common line. On the other hand, *Yue* discloses a system for routing incoming calls to different destinations based upon the information supplied with the incoming call and according to a hierarchical list. Combining these two references would be illogical because the system disclosed in *McAllister* solves the problem of providing different

U.S. Serial No. 08/876,839
Filed: June 16, 1997
RESPONSE TO FINAL OFFICE ACTION, PAPER NO. 20

services to multiple subscribers using a common line. In contrast, the system disclosed in *Yue* solves a problem associated with a subscriber having a plurality of lines. Combination of these references would yield a system where a subscriber's speech is analyzed to determine what services are to be provided and a routing system for incoming calls. However, the combination lacks a system for routing incoming calls to various destinations based on **voice recognition of the originating source**. Therefore, claims 17 and 18 are not obvious under *Yue* in view of *McAllister*. Furthermore, claims 17 and 18 are patentable because they depend ultimately from allowable independent claims 1 and 4.

The preceding arguments address only the arguments in the Action, and therefore may not address patentable aspects of the invention that were not addressed by the Examiner in the Action. The claims may include other elements that are not shown, taught, or suggested by the cited references. Accordingly, the preceding arguments in favor of patentability are presented without prejudice to other bases of patentability.

U.S. Serial No. 08/876,839
Filed: June 16, 1997
RESPONSE TO FINAL OFFICE ACTION, PAPER NO. 20

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please amend claim 27 as follows:

27. (Amended) In an integrated computer telephony system including a call routing system, a method for routing a call based on the identity of an originating source of said call, comprising the steps of:

receiving said call from a first originating source;

identifying said first originating source of said call;

selecting a routing list from a [said] plurality of routing lists based on the identity of said first originating source, each routing list associated with at least one originating source and comprising a plurality of directory numbers, placed in order, where a subscriber can be reached; and

directing said call sequentially to the directory numbers on said routing list.

U.S. Serial No. 08/876,839
Filed: June 16, 1997
RESPONSE TO FINAL OFFICE ACTION, PAPER NO. 20

CONCLUSION

For at least the reasons set forth above, claims 1-18 and 22-27 define patentable subject matter, and issuance of a notice of allowance is respectfully requested. The undersigned thanks the Examiner for extending courtesies in examination of this application.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

No fees are believed due at this time. Nevertheless, the Commissioner is authorized to charge any additional fees which may be due for this Petition, or credit any overpayment, to Deposit Account No. 11-0855.

Respectfully submitted,



Michael K. Dixon
Reg. No. 46,665
Attorney for Assignee

KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, Georgia 30309-4530
Receptionist (404) 815-6500
Direct (404) 815-6619
Attorney Docket No.: 42323/210856
Attorney File No.: 19260/0780
BS File No.: 95041